

PATENT APPLICATION

042390.P9432

Remarks

Reexamination and reconsideration of this application is requested. Claims 1-20 remain in the application. No new claims have been added or canceled.

Applicants believe there is no charge for this response because no new claims have been added.

Response to the 35 U.S.C. §103(a) Rejection

The Office Action also rejects claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over Usui et al. in view of Kaschke. Applicants respectfully traverse this rejection in view of the remarks that follow.

Additional arguments to distinguish the cited patent from claim 1 could have been made, but it is believed that the foregoing discussion is sufficient to overcome the Examiner's rejection.

1) THERE IS NO MOTIVATION TO MAKE THE MODIFICATION PROPOSED BY THE OFFICE ACTION.

As is well established, a prima facie showing of Obviousness may only be established if there is a clear suggestion from or in the prior art to make the modifications proposed by the Examiner. For example, the Court of Appeals for the Federal Circuit stated in Brown & Williamson Tobacco Corp v. Philip Morris Inc., 229 Fed.3d 1120 (Fed Cir. 2000)

"the consistent criterion for determination of obviousness is whether the prior [9] art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success.**

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viewed in the light of the prior art." *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q.2D (BNA) 1529, 1531 (Fed. Cir. 1988). Two requirements are contained in this criterion. The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references [*1125] is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2D (BNA) 1225, 1232 (Fed. Cir. 1998). (emphasis added).

The Office Action made clear that the rejection was based on the assumption that one skilled in the art would be motivated to combine Kaschke with Usui et al. for protection from accidental activation of exposed control keys. Applicants respectfully submit that one skilled in the art would not be motivated as suggested by the Office Action because the devices taught by Usui et al. do not suffer from the problem of accidental activation.

To begin, communication device 1 shown in figures 5, 6, and 8 do not have any exposed keys or controls buttons. Therefore the communication devices do not suffer the problem of accidental activation. Applicants respectfully submit that after reading the teaching of Usui et al., one skilled in the art would not look to Kaschke for solutions or improvements, because the device taught by Usui et al. would not enjoy the suggest benefits offered by Kaschke.

With respect to communication device 1 shown in figures 9 and 10 that does include a sheet switch 121a, Applicants would like to respectfully point out that Usui et al. expressly teaches how the communication device is "... constructed to prevent the wrong operation of the sheet switch 121a." (see column 10, lines 38-41) Usui et al. then goes on to explain how the communication device is constructed and operated so as to prevent accidental operation at column 10, line 40, through column 11, line 2. Again, since Usui et al. already teaches one skilled

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in the art how to address how to prevent accidental activation, there can be no motivation to combine Usui et al. with Kaschke.

**2) THE PROPOSED MODIFICATION OF KASCHKE WOULD RENDER THE
STRUCTURE OF USUI ET AL. UNSATISFACTORY FOR ITS INTENDED PURPOSE**

As discussed in M.P.E.P. §2143.01, if a proposed modification would render the device shown in the cited patent being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The Office Action indicated that the structure shown in Usui et al. could be modified to include a movable antenna of Kaschke because the modification would prevent accidental activation. However, Applicants respectfully submit that the combination of Usui et al. and Kaschke cannot make Applicants claimed invention obvious because the teachings of Kaschke would render the structure taught in Usui et al. unsatisfactory for its intended purpose.

Usui et al. describes with reference to FIG. 7 how the communication device is used with the personal computer. The communication device communicates with the personal computer using the Personal Computer Memory Card International association (PCMCIA) protocol. As discussed at column 8, line 43, through column 9, line 3, the communication device 1 is enabled/disabled using the card enable (CE) signal line upon dictation that the communication device has been inserted into the PC. However, the Office Action suggested modifying this so that the movement of an antennae would disable/enable the communication module. Clearly, the modification proposed by the Office Action is contrary to the teaching of Usui et al. is in conflict with the PCMCIA specification, and would render the communication

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device of Usui et al. unsatisfactory for its intended purpose. Therefore, Applicants respectfully submit that the combination of Usui et al. and Kaschke cannot make Applicants' claims 1-20 obvious. Accordingly, Applicants respectfully traverse the rejection of claims 1-20 in view of the combination of Usui et al. and Kaschke.

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Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed May 22, 2003, and it is submitted that claims 1-20 are in condition for allowance. Reconsideration of the rejection is requested.

Should it be determined that an additional fee is due under 37 CFR §§1.6 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (480) 554-9732 is respectfully solicited.

Respectfully submitted,

Jarvis Tou et al.



Kenneth M. Seddon
Assistant Director
Reg. No. 43,105

Dated: 11-24-2003

c/o Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025-1026
(503) 264-0967